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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,697	04/17/2001	Sylvain Chevreau	PF980072	2501

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/807,697	CHEVREAU ET AL.	
	Examiner	Art Unit	
	Bradley B. Bayat	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 26, 2006.

Status of Claims

This communication is in response to remarks and amendment filed on September 28 2006.

- Claims 1, 7, 11 and 12 have been amended.
- Claims 1-12 remain pending.

Response to Arguments

Applicant's arguments filed on September 28, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the amendment to the claims, namely, "to obtain data formatted specifically for said medium", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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Applicant argues that the cited reference, Akiyama ('699), fails to disclose, "formatting the digital data from said source of digital data using a function based on at least a serial number contained in said medium (response p. 4). Applicant contends that in Akiyama, the data "recorded onto the target storage medium are identical to those contained in the master storage medium."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., formatting using a key dependent on the serial number) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Akiyama in fact discloses a copying system which includes a unique serial number and a storage medium identifier to form a certificate code wherein a certification key operates as a private (secret) key.

As such, Akiyama states:

FIG. 3(B) is a diagram showing the record structure of the MO disc 12, where a storage medium identifier IDk is recorded. Although most part of the MO disc 12 can be freely written and/or read by the end users, the storage medium identifier IDk is written in a special part of the disc that is not rewritable. This storage medium identifier IDk may be a serial number, which is assigned uniquely to each medium at the factory before shipment (column 5, lines 29-38). The subject software program in the CD-ROM 11 has a software identifier SIDI, and the MO disc 12 owns its unique storage medium identifier IDk (column 5, lines 53-56).

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The received software identifier SIDI and storage medium identifier IDk are supplied to a signature processor 14, where the identifiers SIDI and IDk are compressed into a certificate code CS. In this compression process, a certification key REYc operates as a private key (or secret key). The produced certificate code CS will serve as what is referred to as the "signature" in FIG. 1. The certification key REYc used by the signature processor 14 is then directed to an encryption unit 15 to be encrypted with a user key KU, thus producing a ciphertext ECU(REYc). The certificate code CS generated by the signature processor 14 and the ciphertext ECU(FYc) generated by the encryption unit 15 are finally transmitted together with the central site identifier IDc to the end user's site as a response to the request from the end user (column 6, lines 1-13). Accordingly, the examiner respectfully disagrees.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Akiyama et al. (US 5,805,699, hereinafter Akiyama).

As per claim 1, Akiyama discloses a method of copying digital data representative of audio and/or video content from a source of digital data onto a medium, said method comprising the steps of:

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- formatting the digital data from said source of digital data using a function based on at least a serial number contained in said medium to obtain data formatted specifically for said medium, and to thereby prevent bit by bit duplication of the digital data onto another medium (column 3, lines 47-50, target storage medium identifier); and
- recording said formatted data onto said medium (column 3, lines 65-67).

As per claim 2, Akiyama discloses the method of claim 1, wherein the serial number is recorded on the medium during manufacture of the medium (column 4, lines 6-8).

As per claim 3, Akiyama discloses the method of claim 1, wherein the serial number is a unique number for each medium (column 3, lines 48-50).

As per claim 4, Akiyama discloses the method of claim 1, wherein the step of formatting of the digital data to be duplicated is carried out using a secret-key encryption algorithm or a public-key algorithm (column 6, lines 1-6).

As per claim 5, Akiyama discloses the method of claim 4, wherein the encryption algorithm uses an encryption key that is dependent on the serial number (column 6, lines 39-61; figure 5, IDk storage medium identifier).

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As per claim 6, Akiyama discloses the method of claim 5, wherein the encryption key is furthermore dependent on a secret parameter contained in a reading device adapted for reading the digital data arising from said source (column 7, lines 8-23).

As per claim 7, Akiyama discloses a method of copying representative of audio and/or video content onto a medium, wherein the medium comprises a serial number the method comprising the following steps:

- sending of the serial number recorded on the medium to the reading device (figure 2, step S1; IDk sent to central site),
- formatting of the digital data read with the aid of the serial number to obtain data formatted specifically for said medium, and to thereby prevent bit by bit duplication of the digital data onto another medium (figure 2, steps S2, S3; column 4, lines 57-65), and
- recording on said medium the formatted digital data (figure 2, step S7).

As per claim 8, Akiyama discloses the method of claim 7, wherein the formatting step is carried out in the reading device (figure 2, step S4; another certificate code is generated locally at the end user).

As per claim 9, Akiyama discloses the method of claim 7, wherein the reading device comprises means for reading the medium containing the formatted digital data (figure 2, step S5, the locally generated certificate is read and compared with the other certificate).

As per claim 10, Akiyama discloses the method of claim 7, further comprising before performing the duplication of the digital data, a step of checking authorization to copy (figure 2, step S6; if comparison of certificates is verified, allows for duplication of data in S7).

As per claim 11, Akiyama discloses a reading device for reading digital data representative of audio and/or video content and for formatting the digital data to be copied onto a medium, wherein it comprises a formatting circuit adapted for receiving a serial number contained in said medium and providing as output, data formatted specifically for said medium which are dependent on said serial number and are intended to be copied onto said medium (see rejection of claim 1; figure 1 and associated text).

As per claim 12, Akiyama discloses a recording medium for digital data representative of audio and/or video content comprising a serial number which is unique or exhibits a low probability of being common with that of another medium, wherein it furthermore comprises recorded digital data, said digital data being formatted specifically for said medium as a function of said serial number and of a secret parameter (figures 1 and 2 and associated text; column 7, lines 8-23).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from

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the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 6,842,521 B2 to Nakamura for a Method and Apparatus to Control Coping from a Drive Device to a Data Reproducing Device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read "Bradley Bayat". The signature is stylized with a large, looped 'B' and a horizontal line extending from the end.

Bradley B. Bayat
Primary Examiner
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